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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,526	07/27/2000	Evan D.H. Green	NFC1P004X1	1198

7590 12/04/2001  
Cary & Kelly LLP  
1875 Charleston Road  
Mountain View, CA 94043

EXAMINER

JACKSON, CORNELIUS H

ART UNIT	PAPER NUMBER
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2881

DATE MAILED: 12/04/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/626,526		GREEN ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Cornelius H. Jackson		2881	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 September 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 59-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 59-83 and 85-88 is/are rejected.
- 7) ☒ Claim(s) 84 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Acknowledgement*

Acknowledgement is made that applicant's Amendment, filed on 4 September 2001, has been entered. Upon entrance of amendment, claims 33-58 were cancelled and new claims 59-88 were added. Claims 59-88 are pending in this application.

### *Specification*

1. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
2. The disclosure is objected to because of the following informalities: The statement " $FSR_{ChanSel}$  differs from the  $FSR_{GridGen}$  by an amount substantially corresponding to  $1/M * FSR_{GridGen}$ " and "Equation 1B" does not agree with one another, since "Equation 1B" shows the difference between  $FSR_{ChanSel}$  and  $FSR_{GridGen}$  is  $1/(M - 1) * FSR_{GridGen}$  or  $1/(1 - M) * FSR_{GridGen}$ , see page 16, lines 4 and 7-8.

Appropriate correction is required.

### *Claim Objections*

3. Claim 84 is objected to because of the following informalities: Claim 84 is improper since it depends on a cancelled claim.

Appropriate correction is required.

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 59-61, 63, 65-70, 72, 74-83 and 86-87 are rejected under 35

U.S.C. 102(e) as being anticipated by Sesko

et al. (6205159). Sesko et al. teach a tunable

filter apparatus **Fig. 2A**, comprising a grid

generator **4** positioned in an optical path and

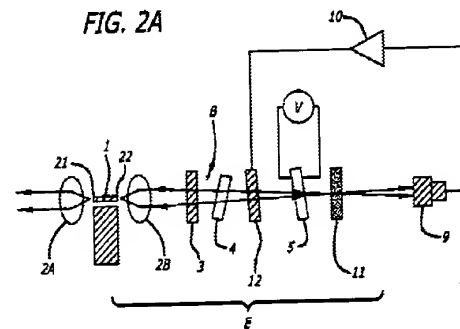
configured to generate a first set of

transmission peaks corresponding to

channels of a selected wavelength grid, **see col. 11, lines 46-49**; and a channel

selector **5** positioned in the optical path and configured to generate a second set of

transmission peaks, **see col. 12, lines 46-48**.



Regarding claim 60, Sesko et al. teach the stated limitation, **see col. 12, lines**

**46-53**.

Regarding claim 61, Sesko et al. teach the stated limitation, **see col. 11, lines**

**35-51**.

Regarding claim 63, Sesko et al. teach the stated limitation, **see claim 59. above**.

Regarding claims 65-66, Sesko et al. teach a gain medium **1**, a retroreflector **11**, a rear facet **21** and other stated limitations, **see col. 13, lines 23-38**.

Regarding claim 67, Sesko et al. teach an error detector **9**.

Regarding claim 68, Sesko et al. teach the grid generator **4** is a first etalon and the channel selector **5** is a second etalon, **see col. 11, line 44**.

Regarding claim 69, **see claim 65 above**.

Regarding claim 70, **see claim 60 above**.

Regarding claim 72, **see claim 63 above**.

Regarding claim 74, **see claim 66 above**.

Regarding claim 75, **see claim 67 above**.

Regarding claims 76-82, the method of a device is not germane to the issue of patentability of the device itself, since the device itself obviously uses the method. Therefore the rejection used on the device applies also to the method of the device.

Regarding claim 83, **see claim 59 above**.

Regarding claims 86-87, **see claims 59-61 and 67 above**.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 62, 64, 71, 73, 85 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sesko et al. (6205159). Sesko et al., as applied to claims 59, 61, 69

and 83 above, teach all the stated limitations except the difference between the first and second free spectral ranges. It has been held, "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 33-58 have been considered but are moot in view of the new ground(s) of rejection, due to the cancellation of claims 33-58 and newly found reference.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cornelius H. Jackson whose telephone number is (703)306-5981. The examiner can normally be reached on 8:30 - 4:00, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dzierzynski can be reached on (703)308-4782. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7722 for regular communications and (703)308-7721 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

CHJ

chj  
November 30, 2001

Dzierzynski  
Primary Examiner  
for  
SPC Dzierzynski